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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/527,974      | 03/17/2000  | Chris Weyand         | 10992045-1          | 4502             |

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EXAMINER

EVANS, ARTHUR G

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2622

DATE MAILED: 10/06/2003

2

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/527,974

Applicant(s)

WEYAND ET AL.

Examiner

Arthur G. Evans

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

Art Unit: 2622

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-3, 5-8, 11, 13-16, are rejected under 35 U.S.C. 102(e) as being anticipated by Monroe.

Note “firmware associated with the imaging system” (firmware of camera or fax of front figure), “communications device adapted and constructed to facilitate communication between the imaging system and a remote source of information” (32 of front figure), “automatic remote firmware update mechanism adapted to selectively and automatically retrieve firmware upgrade information from the remote source of information via the communication device, and to selectively and automatically install the firmware upgrade information into the firmware of the imaging system” (see lines paragraph 0089) of Monroe as claimed in claim 1.

Art Unit: 2622

Regarding claim 2, at least a part of firmware is installed.

Note "communication device is selected from a group consisting of a modem and a network interface card" (see paragraph 0023) of Monroe as claimed in claim 3.

Note "trigger" (see paragraphs 0026-0029, 0035-0036, 0089-00090, figure 9) of Monroe as claimed in claims 5-8, 13-16.

Regarding claim 11, see rejection of claim 1.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 9-10, 12, 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Monroe. Monroe teaches the invention substantially as claimed. However Monroe teaches only telephone system and does not teach "web site" as claimed in claims 4, 12, 19, and 20. Using with sites for firmware information is well known in the same field of inventions as claimed. It would be obvious to one of ordinary skill in the art to use web site in the system of Monroe for the low costs associate with the Internet. Further, Monroe does not teach determine the necessity of installing" as claimed in claims 9, 17 or "notifying a system user" as claimed in claims 10, 18. Determining the necessity of updates and notifying user is well know in the same field of invention as claimed. It would be obvious to one of ordinary skill in the art to determine

Art Unit: 2622

the necessity of an update and notifying user so unneeded updates could be rejected and user would know of upgrade.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Art Evans whose telephone number is (703) 305-9653.

September 30, 2003

  
ART EVANS  
SENIOR PRACTICING EXAMINER